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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91178864
Party	Defendant ELSEVIER INC.
Correspondence Address	Renee Simonton, President Reed Elsevier Intellectual Property FIFTH FLOOR 1105 North Market Street, Suite 501 Wilmington, DE 19801 trademarks@reilaw.com
Submission	Answer and Counterclaim
Filer's Name	Rodrick J. Enns
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Signature	/Rodrick J. Enns/
Date	09/19/2007
Attachments	Answer and Counterclaim.pdf (7 pages)(21498 bytes)

Registration Subject to Cancellation

Registration No	3032209	Registration date	12/20/2005
Registrant	ILSI Health and Environmental Sciences Institute Ninth Floor One Thomas Circle, NW Washington, DC 200055802 UNITED STATES		
Goods/Services Subject to Cancellation	Class 016. First Use: 1989/00/00 , First Use In Commerce: 1989/00/00 Goods/Services: Printed publications, namely, newsletters, books, magazines, pamphlets, journals, monographs, white papers, brochures, printed articles, catalogs, printed supplements, printed agendas, directories, posters, informational flyers, printed announcements, reports, studies, reviews, folders, calendars, bulletins, and treatises in the fields of toxicology, risk assessment, safety assessment, the environment, pathology, and health		
	Class 036. First Use: 1989/00/00 , First Use In Commerce: 1989/00/00 Goods/Services: Providing research grants in the fields of toxicology, risk assessment, safety assessment, the environment, pathology, and health		
	Class 041. First Use: 1989/00/00 , First Use In Commerce: 1989/00/00 Goods/Services: Educational services, namely, arranging, organizing, and conducting symposiums, workshops, and conferences in the fields of toxicology, risk assessment, safety assessment, the environment, pathology, and health		

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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ILSI HEALTH AND
ENVIRONMENTAL SCIENCES
INSTITUTE,

Opposer,

v.

ELSEVIER INC.,

Applicant.

Opposition No.: 91178864

Serial No.: 76651527

ELSEVIER INC.,

Petitioner,

v.

ILSI HEALTH AND
ENVIRONMENTAL SCIENCES
INSTITUTE,

Respondent.

Cancellation No.: _____

Registration No.: 3032209

Registration Date: December 20, 2005

ANSWER TO NOTICE OF OPPOSITION AND
COUNTERCLAIM FOR PARTIAL CANCELLATION

ANSWER

Applicant Elsevier Inc. (“Applicant” or “Elsevier”), through counsel, responds to the Notice of Opposition (“Notice”) filed by ILSI Health And Environmental Sciences Institute (“Opposer” or “ILSI”) as follows, with the numbered paragraphs below corresponding to the numbered paragraphs in the Notice:

1. Applicant is without information sufficient to form a belief as to the truth of the allegations of Paragraph 1 of the Notice, and therefore denies the same.
2. Applicant is without information sufficient to form a belief as to the truth of the allegations of Paragraph 2 of the Notice, and therefore denies the same.

3. Admitted.
4. Admitted.
5. Paragraph 5 of the Notice asserts legal conclusions to which no responsive pleading is required. To the extent that Paragraph 5 of the Notice is deemed to assert facts as to which a responsive pleading is appropriate, such facts are denied.
6. Admitted that Applicant's HESI mark and Opposer's HESI mark are identical. Except as so admitted, the allegations of Paragraph 6 of the Notice are denied.
7. Denied.
8. Admitted that Opposer is not connected in any way with Applicant or its use of Applicant's HESI mark. Denied that Applicant intends to use "Opposer's Alleged Mark".
9. Denied.
10. Denied.
11. Denied.

FIRST AFFIRMATIVE DEFENSE

Opposer has not used in commerce the mark HESI on or in connection with goods or services in fields other than toxicology, risk assessment, safety assessment, the environment, and pathology, or in the alternative has abandoned such use without intent to resume.

COUNTERCLAIM FOR PARTIAL CANCELLATION

Elsevier believes that it will be damaged by the continued registration to ILSI of the mark HESI for use on or in connection with the goods or services listed in Registration No. 3,032,209 ("the ILSI Registration") in fields other than toxicology, risk

assessment, safety assessment, the environment, and pathology, and hereby petitions to partially cancel the ILSI Registration to that extent. In support of its petition, Elsevier alleges as follows:

1. Elsevier, directly and through its predecessor in interest (collectively “Elsevier”), has, continuously since at least January 31, 1990, used the mark HESI on and in connection with the following goods and services (“the Elsevier Goods and Services”):

Computerized educational testing related to nursing; Nurse training; Development and dissemination of educational materials of others in the nature of examinations in the field of nurse training, education and registration;

Computer services, namely design and development of software featuring examinations relating to nursing education, training and registration;

Computerized testing to determine employment skills in the field of nursing.

2. Elsevier has filed Application Serial No. 76/651,527 (“Elsevier’s Application”) to register its HESI mark for the Elsevier Goods and Services in International Classes 41, 42 and 35. Elsevier’s Application was approved for publication by the Trademark Office and was published for opposition on February 13, 2007.

3. ILSI is the owner of record of the ILSI Registration for the mark HESI, which issued December 20, 2005. In the ILSI Registration, ILSI claims first use and first use in commerce of its HESI mark as of 1989 on and in connection with the following goods and services in International Classes 16, 36 and 41:

Printed publications, namely, newsletters, books, magazines, pamphlets, journals, monographs, white papers, brochures, printed articles, catalogs, printed supplements, printed agendas, directories, posters, informational flyers, printed announcements, reports, studies, reviews, folders, calendars, bulletins, and treatises in the fields of toxicology, risk assessment, safety assessment, the environment, pathology, and health;

Providing research grants in the fields of toxicology, risk assessment, safety assessment, the environment, pathology, and health;

Educational services, namely, arranging, organizing, and conducting symposiums, workshops[sic], and conferences in the fields of toxicology, risk assessment, safety assessment, the environment, pathology, and health.

4. ILSI has opposed Elsevier's Application, relying in part on the ILSI Registration to claim a likelihood of confusion arising from Elsevier's use of its HESI mark on and in connection with the Elsevier Goods and Services.

5. Upon information and belief, ILSI has not used the mark HESI on or in connection with any goods or services in fields other than toxicology, risk assessment, safety assessment, the environment, and pathology.

6. In the alternative, ILSI has abandoned any use of the mark HESI on or in connection with any goods or services in fields other than toxicology, risk assessment, safety assessment, the environment, and pathology, and has no bona fide intent to resume such use.

7. Specifically, ILSI has made no use at any time of the mark HESI on or in connection with any goods or services related to the field of nursing or nurse training, education and registration, or alternatively has abandoned any such use without bona fide intent to resume.

8. Elsevier is likely to be damaged by the continued registration to ILSI of the HESI mark for goods and services in fields other than toxicology, risk assessment, safety assessment, the environment, and pathology, and specifically to the extent that the field of "health" as claimed in the ILSI Registration may be deemed to include or extend to nursing or nurse training, education and registration, in that such registration would

prevent Elsevier from exercising exclusive control over the goodwill and reputation associated with its HESI mark as used in the field of nursing and nurse training, education and registration, and would support superior statutory rights for ILSI in such field in violation of Elsevier's prior, superior and exclusive rights.

PRAYER FOR RELIEF

WHEREFORE, Elsevier respectfully prays (1) that the Notice of Opposition be dismissed and that Elsevier's Application proceed to registration; (2) that ILSI's Registration No. 3,032,209 be partially cancelled by striking from the description of goods and services therein the words "and health" wherever they appear, or by otherwise limiting the description of goods and services to the scope of ILSI's actual use, to exclude use on or in connection with any goods or services in the field of nursing and nurse training, education and registration; and (3) for such other relief as may be deemed just and proper.

Please direct all correspondence to Rodrick J. Enns at Enns & Archer LLP, 939 Burke Street, Winston-Salem, NC 27101, 336-723-5180, renns@ennsandarcher.com. Please charge the deposit account of Enns & Archer LLP, No. 501779, for the \$900 filing fee and any other fees incurred in connection with this filing.

Respectfully submitted via ESTTA, this the 19th day of September, 2007.

ENNS & ARCHER LLP

/Rodrick J. Enns/

Rodrick J. Enns

Attorney for Applicant and Petitioner
Elsevier Inc.

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CERTIFICATE OF SERVICE

I hereby certify that on this date I served the foregoing upon counsel of record by depositing a copy thereof in the United States mail, first class, postage prepaid and addressed to:

Mr. Shawn N. Sullivan
ILSI Health and Environmental
Sciences Institute
One Thomas Circle, NW, 9th Floor
Washington, DC 20005

This the 19th day of September, 2007.

/Rodrick J. Enns/
Rodrick J. Enns

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